

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of	:	Customer Number: 46320
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Radhika AGGARWAL, et al.	:	Confirmation Number: 2419
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Application No.: 10/041,141	:	Group Art Unit: 2178
	:	
Filed: January 30, 2002	:	Examiner: T. Huynh
	:	
For: INLINE ERROR HIGHLIGHTING	:	

Mail Stop AF  
Commissioner For Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**REQUEST FOR PRE-APPEAL BRIEF REVIEW**

Sir:

Applicants request that a Panel Review of the final rejection in the Fourth Office Action dated February 24, 2006, be performed in the above identified application.

**CLAIMS 1-2, 5-7, AND 10 ARE REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS**  
**BASED UPON UPTON ET AL., U.S. PATENT PUBLICATION NO. 2003/0105884 (HEREINAFTER**  
**UPTON), IN VIEW OF JEFFRIES ET AL., U.S. PATENT NO. 6,094,529 (HEREINAFTER JEFFRIES),**  
**AND FURTHER IN VIEW OF HOMER ET AL., "INSTANT HTML," COPYRIGHT 1997, PAGES 88-**  
**101 (HEREINAFTER HOMER)**

On page 3 of the Request for Reconsideration filed December 2, 2005, Applicants noted that the filing date of the present application is January 3, 2002, whereas the filing date of Upton is October 15, 2002. Thus, the Examiner cannot be relying upon the disclosure of Upton for the

rejection, but instead, the Examiner must therefore be relying upon the disclosure in a U.S. Provisional Application upon which Upton claims priority.

Applicants also cited M.P.E.P. § 2136.03(III) for the proposition that the filing date of the provisional application can be relied upon by the Examiner only "if the provisional application(s) properly supports the subject matter relied upon to make the rejection in compliance with 35 U.S.C. 112, first paragraph." On page 4 of the Request for Reconsideration, Applicants also cited 37 C.F.R. § 1.104(c)<sup>1</sup> for the argument that "the Examiner must clearly designate the teachings in the '919 provisional application being relied upon the statement of the rejection." Since the Examiner had not cited to the '919 provisional application, that burden had not been met.

The Examiner's response to this argument is found on page 7 of the Final Office Action dated February 24, 2006, in which the Examiner asserted the following:

It is noted that Upton claims priority filing date for U.S. Provisional Applications 60/347,919 and 60/347,901. The 60/347,901 provisional application properly supports the subject matter relied upon by the Examiner to make the rejection of claims 1-2, 5-7 and 10 (See 60/347,901; pages 8-3 to 8-9).

The Examiner's reference to "pages 8-3 to 8-9," however, still does not meet the requirements of 37 C.F.R. § 1.104(c), which requires that "the particular part relied on must be designated as nearly as practicable."

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<sup>1</sup> 37 C.F.R. § 1.104(c) provides:

In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

It is practicable for the Examiner, for each of the claimed elements, to specifically identify each feature within the '901 provisional application being relied upon to teach each of the particular claimed elements. For example, the Examiner can "specifically identify" a feature, corresponding to the claimed element, within the applied prior art by identifying a reference numeral associated with the feature. In addition to or alternatively, the Examiner may cite to a brief passage (i.e., 1 or 2 lines or even a portion of a line) within the applied prior art that identifies the feature that corresponds to the claimed element. However, merely citing seven whole pages to disclose multiple claimed elements does not designate "as nearly as practicable," the particular features within the '901 provisional application being relied upon by the Examiner in the rejection.

Notwithstanding the Examiner's failure to meet the requirements of 37 C.F.R. § 1.104(c), Applicants further note that the Examiner is relying upon the '901 provisional application to teach the claimed "selecting error text corresponding to said validation error and inserting said selected error text in said row" (see page 3 of the Final Office Action). Although the Examiner has asserted that this feature is disclosed in pages 8-3 to 8-9 of the '901 provisional application, Applicants respectfully disagree.

Discussions of "error messages" are found in paragraphs 3 and 4 on page 8-3; the section entitled "Word and Its Descendants" on page 8-5; and the section entitled "AbstractInputTagSupport and Its Descendants" on page 8-6. Upon reviewing these passages, Applicants note that none of these passages support the Examiner's assertion that the '901 provisional application identically discloses the limitation reproduced above. The '901

provisional application only teaches that the "error message should be localized for the user's preferred locale if the web application supports multiple locales" and that the "form will need to be re-displayed to the user with a localized error message at the top of the page." Therefore, the '901 provisional application fails to teach selecting error text corresponding to the validation error. Instead, the error message is based upon the "user's preferred locale" and not on the validation error. Thus, the '901 provisional application fails to teach the limitations for which the Examiner is relying on the '901 provisional application to teach.

Therefore, even if one having ordinary skill in the art were motivated to modify the '901 provision application (i.e., Upton) in view of Jeffries and Homer, the claimed invention would not result. Thus, for all the reasons stated above, Applicants submit that the rejection of record is clearly not proper and is without basis, and Applicants respectfully solicit withdrawal of the imposed rejections of claims 1-2, 5-7, and 10 under 35 U.S.C. § 103 for obviousness based upon Upton in view of Jeffries and Homer.

**CLAIMS 3-4 AND 8-9 ARE REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON UPTON IN VIEW OF JEFFRIES AND HOMER AND FURTHER IN VIEW OF HARTMANN, U.S. PATENT NO. 6,615,226**

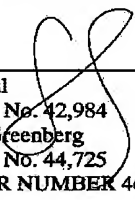
The additional reference to Hartmann does not cure the deficiencies of the prior rejection, and thus Applicants respectfully solicit withdrawal of the imposed rejection of claims 3-4 and 8-9 under 35 U.S.C. § 103 for obviousness based upon Upton in view of Jeffries, Homer, and Hartmann.

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To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

Date: May 24, 2006

Respectfully submitted,



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